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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/666,653	06/18/1996	TSUTOMU HONDA	024060-064	7870

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BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER

MOE, AUNG SOE

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/666,653

Applicant(s)

Honda et al.

Examiner

Aung Moe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 26, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-26 and 31-42 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☒ Claim(s) 19-26 is/are allowed.
- 6) ☒ Claim(s) 31-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed Nov. 26, 2002 have been fully considered but they are not persuasive.

Regarding claims 31-42, the Applicant alleged (in page 7 of the remarks) that Ootsuka '754 merely discloses that if a still image mode (either silver-halide or electronic) is set, the displayed image is from the internal memory 129 or frame memory (column 27, lines 40-44). Thus, nothing in Ootsuka '754 shows, teaches or suggests "***a mode in which a still image is reproduced out of a picture recorded and reproducible as a moving picture***" as claimed in claims 31, 35, 39 and 41.

In response, the Examiner respectfully disagrees with the Applicant's position because the Applicant clearly admitted that Ootsuka '754 clearly discloses "a preview mode" for displaying a still picture (i.e., See pages 6-7 of the Applicant remarks) when the switch Sdpi is selected for the "preview modes" as shown in Fig. 38. Furthermore, Ootsuka '754 clearly discloses that the still image reproduced during the "preview mode" is a picture which is recorded and reproduced as the moving picture on the second recording unit (i.e., the recording unit 50 of as shown in Fig. 2; col. 6, lines 30-35). In other words, it is cleared from Figs. 3 and 18, the still image and the moving picture may be recorded on the second recording unit (i.e., the recording unit 50 which includes the recording medium 52, the IC Card 52, and the frame

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memory 129) and when the "preview mode" is selected by switch Sdpi, this still image, which is recorded and reproducible as the moving picture on the second recording unit, may be reproduced during a "preview mode" as discussed in column 27, lines 25+ and col. 29 lines 40+.

However, it is noted that although Ootsuka '754 shows the use of second recording mediums (i.e., the Tape 52, IC 51 and Memory 129) and reproducing the still image out of the second recording unit (i.e., the recording units 50/129) where the moving picture is also recorded for the purpose of reproducing as discussed above, Ootsuka '754 does not explicitly state that the still image may be recorded on the second recording medium where the moving picture signal is also recorded so that the still image may be reproduced out of the second recording medium where the recorded moving picture is reproducible from the second recording medium as required present claimed invention. In other words, Ootsuka '754 does not show the use of a single second recording medium for recording/reproducing both still and moving picture therein.

However, the above mentioned claimed limitations are rendered obvious by Kozuki '943. In particular, Kozuki '943 teaches that it is conventionally well-known to use a single second recording medium for recording/reproducing both still and moving picture therein (i.e., noted from Figs. 3 and 5 that the still/moving pictures are recorded on the tape 1 and the still/moving pictures may be reproduced as well) so that the still image may be reproduced out of the picture recorded and reproducible as the moving picture from the second recording medium (i.e., noted from Figs. 3 and 5 that the recorded moving picture on the recording area MV may be reproducible).

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In view of the above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ootsuka '754 by replacing the second recording medium (52) with the recording medium (1) of Kozuki '943 so that both the still/moving pictures may be recorded for the purpose of reproducing therefrom if the user place the camera's operation in the "Preview Mode" and moreover, such modification clearly would reduce the size and cost of the overall system because the use of multiple memory for storing the still/moving pictures may be eliminated.

In addition, the Applicant alleged (in page 8 of the remarks) that Kozuki '943 does not show, teach or suggest "a still picture is reproduced out of a picture recorded and reproducible as moving picture" as amended in claims 31, 35, 39 and 41.

In response, it is noted that Kozuki '943 reference is used to show the well-known feature such that a second recording medium for recording/reproducing the still/moving pictures as discussed above. Furthermore, it is clearly obvious from Figs. 3 and 5 of Kozuki '943 that the still picture recorded on the still recording area (SV) of the second recording medium (1) may be reproduced out of the picture recorded and reproducible as the moving picture on the second recording medium because the still picture recorded (Ai) on the second recording medium (1) is clearly related to the reproducibly recorded moving picture (A1-An) on the second recording medium (1). Therefore, when the system of Ootsuka '754 is modified as taught by Kozuki '943, the still picture (Ai) may be reproduced out of the picture recorded and reproducible as the moving picture (A1-An) on the second recording medium (1) during the "preview mode".

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In view of the above discussion, it is clearly obvious that when considering the combination of Ootsuka '754 and Kozuki '943 as a whole, the claimed invention of a mode in which still picture is reproduced out of a picture recorded and reproducible as a moving picture is clearly taught and therefore rendered obvious by the combination of Ootsuka '754 and Kozuki '943.

Claims 31-42 are obvious over Ootsuka '754 in view of Kozuki '943 for at least the reasons discussed above, thus, the Examiner will maintain the rejection as follows:

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 31-33, 34-38 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ootsuka '754 (U.S. 5,774,754) in view of Kozuki et al. (U.S. 5,589,943).

Regarding claim 31, Ootsuka '754 discloses a photographing apparatus (*see Figs. 2 and 18*) comprising:

a first recording section for recording, on a first recording medium (*i.e., noted the use of a silver salt film as shown in Fig. 4*), mainly still pictures together with information relating to the still pictures thus recorded (*as shown in Figs. 4 and 5A, it is noted that with the use of the magnetic recording circuit, the information relating to the still pictures recorded on the film may be recorded on a magnetic recording layer of the film so that such information may be used when a still picture recorded on the film is printed; see col. 7, lines 10+*);

a second recording (*i.e., noted the use of Memory 50*) section capable of recording moving pictures and also pictures to be reproduced as still pictures (*i.e., col. 6, lines 30+*); and

a controller (Figs. 1 and 18, the elements 1 and 100) for controlling the photographing apparatus (*i.e., the system 20*), which is operated by a voluntary operation (*i.e., noted the use of manual switches as shown in Fig. 3 for allowing the user to perform a voluntary operation*) a plurality of shooting and reproducing modes (*i.e., noted that with the use of control units 1 and 100 and the input units, e.g., the elements 24-25, 39, & 40, the user may select among a plurality of shooting and reproducing modes; see col. 6, lines 29+ and col. 27, lines 20+*), said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium (*see Figs. 4 & 5A, col. 6, lines 40+ and col. 7, lines 3+*),

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a mode in which a moving picture is recorded on the second recording medium (50), and a mode in which a picture to be reproduced as a still picture is recorded on the second recording medium (*i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory unit 50, so that they may be reproduced to display on the display monitor; see Figs. 8, 12-13, 18 and 38, the elements 50 & 127; col. 15, lines 60+ and col. 27, lines 20+*),

said reproducing modes including a mode in which information relating to a still picture recorded on the first recording medium is displayed (*Figs. 13-14, col. 10, lines 45+, col. 12, lines 10+, col. 11, lines 20+ and col. 23, lines 40+*),

a mode in which a moving picture recorded on the second recording unit (50) is reproduced (*col. 15, lines 65+ and col. 28, lines 25+*),

a mode in which the still picture recorded on the second recording unit (50) is reproduced (*col 32, lines 30-35*), and

a mode in which a still picture is reproduced (*i.e., Noted that during the "Preview" mode, the "STILL IMAGE" can be reproduced while the camera is in a motion recording mode; see col. 13, lines 50+, col. 27, lines 40+*) out of a picture recorded and reproducible as a moving picture on the second recording unit (*i.e., the memory device 50 as shown in Figs. 2 & 3*).

Further, although Ootsuka '754 discloses the use of "a second recording unit" for recording the motion image in the recording medium 52 and recording the still image in the recording unit 51, Ootsuka '754 does not explicitly show the use of particular "a second



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recording medium” for recording the still image and the moving image therein as recited in the present claimed invention.

However, Kozuki ‘943 clearly teaches it is conventionally well-known in the art to use a “second recording medium” (i.e., noted the use of recording medium 1 as shown in Figs. 3 and 5 of Kozuki ‘943) for recording/reproducing the moving image data (i.e., noted the MV portion recorded on the recording medium 1) and the still image data (i.e., noted the SV portion recorded on the recording medium 1) so that the moving image data (i.e., noted the MV data recorded on the tape 1 during the period T1/T2) and the still image data (i.e., noted the SV data recorded on the tape 1 during the period T2/T6) may be reproduced from the same recording medium. Furthermore, it is noted that the still image data portion (i.e., noted the still image data Ai recorded during the T1/T2 as shown in Fig. 3) out of a picture recorded as a moving picture on the recording medium (i.e., the moving image data A1-An recorded during the T1/T2) may be selectively extracted and reproduced as desired by the user.

In view of this, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ootsuka ‘754 as taught by Kozuki ‘943, since such a modification would obviously reduce the cost and size of the overall system of Ootsuka ‘754 because it is only require to use a single recording medium to record the still and moving image data as taught by Kozuki ‘943.

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Regarding claim 32, Ootsuka '754 discloses wherein the information recorded on the first recording medium is information used when the still picture recorded on the first recording medium is printed (i.e., see col. 6, lines 60-col. 7, line 1 of Ootsuka '754).

Regarding claim 33, Ootsuka '754 discloses wherein, in any of the modes in which the moving picture is recorded, as aspect ratio of the picture can be varied (col. 23, lines 35+ and col. 24, lines 1+ of Ootsuka '754).

Regarding claim 34, Ootsuka '754 discloses a display for displaying the still picture, the moving picture, or information in any of the reproducing mode (i.e., see Figs. 12-17 of Ootsuka '754).

Regarding claim 35, please see the examiner's comment with respect to claim 31 as discussed above.

Regarding claim 36, please see the examiner's comment with respect to claim 32 as discussed above.

As for claim 37, please see the examiner's comment with respect to claim 33 as discussed above.

Regarding claim 38, please see the examiner's comment with respect to claim 34 as discussed above.

Regarding claim 39, please see the examiner's comment with respect to claims 31 & 33 as discussed above.

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Regarding claim 41, please see the examiner's comment with respect to claim 31 & 33 as discussed above.

Regarding claims 40 and 42, Ootsuka '754 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes (see Figs. 12-17 of Ootsuka '754).

*Allowable Subject Matter*

4. Claims 19-26 are allowed for the reasons set forth in the previous Office action (please see paper no. 7 & 12).

*Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Or Faxed to:**

**(703) 872-9314**, (for formal communications; please mark **“EXPEDITED PROCEDURE”**; and for informal or draft communications, please label **“PROPOSED”** or **“DRAFT”**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is **(703) 306-3021**. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 5:00 P.M.

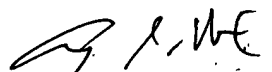
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application should be directed to the customer service number (703) 306-0377.

A. Moe

January 29, 2003

  
**AUNG S. MOE**  
**PATENT EXAMINER**